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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,934	03/30/2001	David W. Cancell	05725.0878-00	4153

22852 7590 09/22/2004

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EXAMINER

CHANNAVAJALA, LAKSHMI SARADA

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/820,934

**Applicant(s)**

CANNELL ET AL.

**Examiner**

Lakshmi S Channavajjala

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-186 is/are pending in the application.
- 4a) Of the above claim(s) 10-12, 20-28 ad 60-186 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 13-19 and 29-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5-21-04 has been entered.

Claims 1-186 are pending in the instant application. Claims 1-9, 13-19 and 29-59 read on the elected species and are considered for examination. Claims 10-12, 20-28 and 60-186 are withdrawn from consideration.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-9, 13-19 and 29-59 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-100 of copending Application No. 09/820,812. Although the conflicting claims are not identical, they are not patentably distinct from each other because both instant claims and the copending claims

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recite composition comprising C3 to C5 monosaccharides substituted with a carbon chain having C1 to C22 atoms and both the inventions are directed to using the compositions for treating hair.

Instant claims recite the above monosaccharides in combination with film-forming polymers, which is also claimed in the dependent claims of the co-pending application. Accordingly, it would have been obvious for a skilled artisan at the time of the instant invention to use the composition of copending claims, which is also used for providing hair treatment.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1-9, 13-19 and 29-59 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 57-166 of copending Application No. 09/820,856. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending claims directed to a method of durable permanent shaping of hair by applying a composition comprising C3 to C5 monosaccharides substituted with a carbon chain having C1 to C22 atoms and film-forming polymer has the same scope as that of the instant claimed composition. The film-forming polymers of co-pending claims are generic and encompass the quaternary ammonium containing film-forming polymers of the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1-9, 13-19 and 29-59 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-85, 152 and 153 of copending Application No. 09/821,480. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are obvious over the copending claims. Instant claims are drawn to a composition containing C1 to C22 substituted C3 to C5 monosaccharides, and method of protecting hair using the same. Copending claims are drawn to a composition containing C3 to C5 monosaccharides, with film forming polymers of the instant claims. The monosaccharides, film forming polymers and their amounts claimed in the copending application are same as that of the instant. While both sets of claims recite different purposes (i.e., shaping of hair or conditioning of hair), it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to use the composition of copending claims containing C3 to C5 monosaccharides and film forming polymers of because the copending claims teach C3 to C5 monosaccharides, which include both substituted and unsubstituted monosaccharides. Further claim 139 of the copending claim specifically states substituted C1 to C22 monosaccharides. Accordingly, one of ordinary skill in the art would have expected that the composition of copending claims i.e., C1 to C22 substituted C3 to C5 monosaccharides and film forming polymers condition the hair as well as impart durable non-permanent shaping to the hair.

4. Claims 1-9, 13-19 and 29-59 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, 10-17, 27-65, 75-105, 108-115, 125-145 of U.S. Patent No. 6,486,105. Although the conflicting claims are not

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identical, they are not patentably distinct from each other because both sets of claims recite compositions containing film-forming polymers containing at least two quaternary ammonium groups and the C3 to C5 monosaccharides and their derivatives of patented claims are generic to the instant claimed C3 to C5 monosaccharides substituted with C1 to C22.

***Claim Rejections - 35 USC § 103***

5. Claims 1-9, 13-19 and 29-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,004,545 to Karlen et al (Karlen) and US 5,688,930 to Bertho et al (hereafter Bertho).

Karlen teaches a hair cleansing composition comprising two essential ingredients - a vinyl/silicone copolymer and a surfactant. Among the surfactants, Karlen specifically teaches alkyl glucosides as suitable for the invention (col. 4, lines 23-38 and examples). Karlen further teaches the addition of hair conditioning polymers such as Polymer JR (col. 7, lines 45-67), also disclosed in the instant specification that reads on the claimed film-forming polymer. Karlen fails to teach the claimed pentoses or XYLIANCE (elected by applicants).

Bertho teaches alkyl pentosides from wheat products, which is a mixture of glycosides such as glucose, xylose and arabinose (col. 2, lines 35-45). Thus, xylose is a part of the pentoside. Bertho teaches the mixtures as surfactants for hair care (col. 6, lines 14-34). The alkyl groups of Bertho range from 6-22 carbons, specifically 14-20 C, which is within the claimed range, (col. 3, lines 53-67 and col. 7, lines 6-9), at a concentration of 0.1% to 60% (col. 7, lines 13-18).

Therefore, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to replacing alkyl glycoside in the composition of Karlen, by adding the

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alkyl pentoside mixture of Bertho because Bertho suggests that their raw material is cheap having economic advantage (col. 1, lines 35-45) and has the ability to act as a surfactant, enhance foaming, emulsifying and detergent power (col. 6, lines 33-35). One of an ordinary skill in the art would have expected to improve the emulsifying power of the composition of Karlen with a cheaper material of Bertho.

6. Claims 1-9, 13-19 and 29-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,495,498 to Niemiec et al (hereafter Niemiec) and US 5688930 to Bertho et al (hereafter Bertho).

Neimeic teaches detergent and conditioning compositions containing a silicone agent, a conditioning agent, surfactants and detergent, for treating hair, skin or nails, particularly as shampoos. The cationic compounds of Neimeic include cationic cellulose derivatives such as Polymer JR-400 and Polyquaternium-10 (col. 6, lines 2-13), also described in the instant specification as a suitable film-forming agent. Neimeic further teaches adding surfactants, suspending agents; film-forming agents and other hair care actives in the composition. Among the film-forming agents, Neimeic teaches instant claimed polymers such as Polyquaternium-10 as suitable for forming a continuous coat on the hair (col. 13, lines 1-9). Thus, Neimeic teaches Polyquaternium-10 as essential in the composition for conditioning and film-forming effect. Neimeic teaches incorporating surfactants in the composition for cleansing but fails to teach the claimed monosaccharides.

Bertho, discussed above, teaches the claimed alkyl pentosides as surfactants for hair care compositions. Accordingly, it would have been obvious for one of an ordinary skill in the art at

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the time of the instant invention to add alkyl pentoside mixture of Bertho in the hair composition containing the Polyquaternium-10 hair conditioner (and film-forming agent) of Neimeic because Bertho suggests that their raw material is cheap having economic advantage (col. 1, lines 35-45) and has the ability to act as a surfactant, enhance foaming, emulsifying and detergent power (col. 6, lines 33-35), which is also desired Neimeic because Neimeic is directed to a hair shampoo and conditioning composition containing detergent surfactants as well as conditioners. One of an ordinary skill in the art would have expected to improve the emulsifying power of the composition of Neimeic with a cheaper material of Bertho.

### ***Response to Arguments***

7. Applicant's arguments filed 5-21-04 have been fully considered but they are not persuasive.

Double patenting rejection: Applicants traverse the double patenting rejection over the co-pending application 09/821,480 and state that the rejection be held in abeyance until allowable subject matter is indicated. However, at this time no claims are indicated allowable and for the reasons mentioned in the previous action (and also in the preceding paragraphs), the rejection has been maintained.

Applicants' arguments with respect to the rejection of claims as being obvious over Bertho and Naser are moot, in view of the new grounds of rejection.

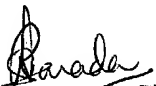


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 7.30 AM -4.00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lakshmi S Channavajjala  
Examiner  
Art Unit 1615  
September 15, 2004